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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,811	07/27/2000	Kotaro Oami	5000-4777	9671

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/626,811	Applicant(s) OAMI ET AL.	
	Examiner Jane J Rhee	Art Unit 1772	

80.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Repeated

1. The 35 U.S.C. 102 (b) rejection of claims 7-14 anticipated by Keng has been repeated for the reasons previously stated in Paper 15.

Response to Arguments

2. Applicant's arguments filed 2/04/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that "placing between" as described by Keng does not teach or suggest "forming on", as claimed in independent claim 7, however, by definition, "forming" is defined as to put in order; arrange¹ and "placing" is defined as to put in a specified relation or order², therefore since both definitions are the same, Keng does teach and suggest that the document is "formed on" a binder layer as required by independent claim 7.

In response to applicant's argument that since the document is being prepared and later inserted between the shield device, hence, Keng does not teach or suggest "the first binder layer, printed part and second binder layer are formed in this order," however as discussed above "placing" and "forming" was concluded to have the same

¹ *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

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definition therefore, the first binder layer, printed part and second binder layer are formed in this order as required by independent claim 7.

In response to applicant's argument that the office action points out that element 18 is the first binder layer wherein 18 is part of shield device 16 and that document 10 is not formed on shield 16, however, examiner would like to point out that on the bottom of page 2 of the office action the first binder layer is pointed out to be element number 19 and that element number 18 is the second binder layer as pointed out on top of page 3, therefore, the printed part is "formed on" the first binder layer as required by independent claim 7.

Thus, in the absence of any evidence to the contrary, it remains the Examiner's position that the claimed invention is anticipated over the prior art of record discussed above. The new limitation "wherein the first binder layer, printed part and second binder layer are formed in this order" was already taught by Keng in figure 2. Keng discloses a resin panel body (figure 2 number 11), an insert film (figure 2 number 10) arranged on a surface of the resin panel body (figure 2 number 11), the insert film comprising a resin film (figure 2 number 10 and 14, col. 2 line 31), a first binder layer formed on the surface of the resin film (figure 2 number 19), a printed part formed on the first binder layer (figure 2 number 10), a second binder layer formed so as to seal the printed part in cooperation with the first binder layer (figure 2 number 18) and the second binder layer contacting the first binder layer along a periphery of the printed part (figure 2 number 18, 19), wherein the first binder layer, printed part and second binder layer are formed in this order (figure 2).

The following are new grounds of rejection for the newly presented limitation in claims 7-14 and new presented claim 15 in amendment filed on 2/04/2004.

New Rejections

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Keng (5362540).

Keng discloses a resin panel body (figure 2 number 11), an insert film (figure 2 number 10) arranged on a surface of the resin panel body (figure 2 number 11), the insert film comprising a resin film (figure 2 number 10 and 14, col. 2 line 31), a first binder layer formed on the surface of the resin film (figure 2 number 19), a printed part formed on the first binder layer (figure 2 number 10), a second binder layer formed so as to seal the printed part in co-operation with the first binder layer (figure 2 number 18) and the second binder layer contacting the first binder layer along a periphery of the printed part (figure 2 number 18, 19), wherein the first binder layer, printed part and second binder layer are formed in this order (figure 2). Keng discloses that the resin panel body is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer (figure 2 number 14 and 19). Keng discloses that the second binder layer covers the periphery of the first binder layer to directly adhere closely to the

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resin film (figure 2 numbers 18,19 col. 3 lines 6-8), the resin panel body directly adheres closely to the resin film on an outer side of the periphery of the second binder layer (figure 2 number 18,12). Keng discloses that the material of the resin panel body is the same as that of the resin film, which is polycarbonate (col. 2 line 67). Keng discloses that the periphery of the second binder layer is printed to overlap the periphery of the first layer (figure 2 numbers 18 and 19). Keng discloses that the printed part is coated along the periphery of the insert film (figure 2 number 10). Keng discloses that the printed part is a document (col. 2 line 19) which inherently consist of ink by definition therefore the printed part of the document is ink.

As to the claim wherein the resin panel is a window for automobiles, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely

because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation wherein the resin body is integrally molded with the insert film by inserting molding so that a surface of the resin film of the insert film at the side on which a printed part is formed faces an inside of the resin panel is a method of production and therefore does not determine the patentability of the product itself.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 571-272-1499.

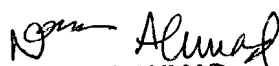
The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Ahmad can be reached on 571-272-1487. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
May 7, 2004


NASSER AHMAD
PRIMARY EXAMINER